

### **REMARKS/ARGUMENTS**

These remarks are made in response to the Office Action of May 28, 2004 (Office Action). As this response is timely filed within the 3-month shortened statutory period, no fee is believed due.

In paragraphs 1-20 of the Office Action, claims 1-3, 5-13, 16-20 have been rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Number 6,587,835 to Treyz *et al.* (Treyz). In paragraphs 21-30 of the Office Action, claims 4 and 14-15 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Treyz in view of U.S. Patent Number 5,218,633 to Clagett *et al.* (Clagett) in further view of Official Notice.

Applicants have added dependent claims 21, 22, and 23 to emphasize that the kiosk can function as a wireless access point for accessing an Internet. Support for these dependent claims can be found in FIG. 1 by items 110, 100, 130, and 140; in FIG 4 (where the Personal Area Network or PAN can be a wireless network like an 802.11 network); and in corresponding sections of the Applicants' specification. No new matter has been added.

Prior to addressing the rejections on the art, a brief review of the Applicants' invention is in order. The present invention details a system and method for providing kiosk service offerings in a personal area network (PAN). More specifically, a kiosk, for example a public telephone, a gasoline station island, an airline check-in desk, a ticketing booth, a retail check-out counter, a toll booth, or an automatic teller machine, can be configured with a short-range wireless communications system for transmitting and receiving data. Notably, the kiosk can be communicatively linked to an existing communications network. The kiosk can establish short-range radio communications links with wireless devices which enter the PAN. Once a short-range radio communications link has been established with the wireless device, the kiosk can retrieve over the existing communications network selected electronic services such as applications and data. The kiosk, in turn, can transmit the retrieved selected electronic services to the wireless device over the wireless communications link.

Turning to the rejections on the art, in paragraphs 1-20 of the Office Action, claims 1-3, 5-13, 16-20 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Treyz. Treyz discloses a handheld device that can be used to provide a user with shopping

assistance services. These services include such things as maintaining shopping lists and receiving directions in a mall.

Referring to claim 1, Applicants claim:

A method for providing kiosk service offerings comprising:

configuring a kiosk to provide electronic services over short-range radio communications links to wireless devices in a personal area network (PAN), said kiosk also configured to communicate over **an existing physical communications link medium**;

establishing a short-range radio communications link with a wireless device in said PAN;

retrieving selected electronic services over **said existing physical communications link medium**; and,

delivering said retrieved selected electronic service.

Treyz fails to teach a system and/or method that communications **over an existing physical communications link medium**, as explicitly claimed in the configuring and retrieving steps. Instead, column 61, lines 35-36 of Treyz states "audio files may be downloaded from audio database 1018 to computer 1024 over a communication network 1022, such as an Internet." In contrast, Applicants teach that an existing physical communicational link **medium** (like a pay phone and associated telecommunication infrastructure equipment) can be re-purposed to wirelessly provide electronic services. Accordingly, "heretofore single purpose existing kiosks, such as payphones, ticket counters and gasoline station islands, can be extended to offer new electronic services, thereby adding value to these existing kiosks," as stated at page 3, lines 8-11.

Similarly, independent claims 12 and 18 explicitly include the limitation of communicating **over an existing physical communications link medium**, which is not taught by Treyz.

Regarding claims 3 and 20, Applicants claim "retrofitting an existing kiosk". Treyz fails to teach retrofitting an existing kiosk in any manner. (No mention of retrofitting an existing kiosk exists in FIG 107 or column 61, lines 8-31 that was cited by the Examiner in paragraph 6 of the Office Action.)

Regarding claim 6, Treyz teaches using a handheld device to remotely use a service. Treyz does not teach downloading a selected application to a kiosk (so that it can be locally

executed at any time). The downloading of an application is explicitly claimed by the Applicants by stating "retrieving an application".

Regarding claim 9, Treyz does not teach the step of "determining if said specified electronic services wholly reside in said kiosk," which is used to use a local service when available instead of using a remote service of the same type available over a network connection. (No mention of this limitation exists in FIG 107 or column 61, lines 26 that was cited by the Examiner in paragraph 6 of the Office Action. Instead Treyz teaches that audio can be downloaded upon to handheld device.)

Regarding claim 10, Treyz does not teach determining where components within a multi-component reside, using a local copy when available, and otherwise downloading components as claimed by the applicants. This step indicates that local component should be used when available instead of using a remote component of the same type to minimize network activity. Instead, Treys teaches that files within the handheld device can be updated.

Regarding claim 12, Treyz does not teach "said list residing locally in said kiosk and remotely in said servers in said communication network." Instead Treys indicates a top 40 pick of audio files can be presented upon a handheld screen. Treys provides no indication as to where the list resided. Appreciably, the configuration claimed by the Inventors is not the typical manner in which a list would be stored and is therefore not "inherently" disclosed by Treyz.

For the reasons stated above, Treyz does not anticipate the Applicant's invention. Accordingly, the 35 U.S.C. § 102(e) rejections to claims 1-3, 5-13, 16-20 should be withdrawn, which action is respectfully requested.

In response to the 35 U.S.C. § 103(a) rejection, Applicants have enclosed affidavits under 37 C.F.R. § 1.131 supporting the removal of Treyz as a reference. The affidavits are accompanied by a copy of the Applicants' confidential invention disclosure (Disclosure) entitled "Multi Tier ASP/Software Delivery for Wireless Devices." The confidential invention disclosure and affidavits demonstrate proof of conception for the claimed subject matter of the Applicants' invention at least as early as January 26, 2000, which predates the effective date of Treyz that is February 9, 2000. Applicants further exercised due diligence from prior to the effective date of Treyz until March 9, 2001 the filing date of the instant application.

To demonstrate due diligence from at least as early as January 26, 2000 until March 9, 2001, Applicants have submitted correspondence showing that the submission of the Disclosure by the client to the prosecuting law firm on July 20, 2000. A draft of the application was prepared by the prosecuting firm on January 23, 2001. Comments to the draft were received, and changes were applied to the present application, which was finalized and subsequently filed on March 9, 2001. It should be noted that between January 26, 2000 and July 20, 2000 the invention was within a review and evaluation process internal to the client. Based upon results of the review process, the client chose to obtain patent rights for the present invention, thereby submitting the Disclosure on July 20, 2000 to the prosecuting law firm.

Since Applicants conceived of the present invention before Treyz and exercised due diligence in constructively reducing the invention to practice, Treys should be withdrawn as a reference for purposes of 35 U.S.C. § 103(a). Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejection with respect to claims 4 and 14-15 is respectfully requested.

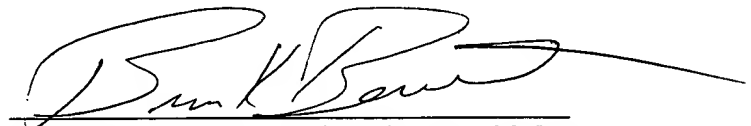
Regarding the Official Notice in paragraphs 24 and 30, the Examiner asserts that it would have been obvious to implement the Treyz communication network as a telephone communication link. Applicants point out that Treyz is a shopping assistance system that is intended to be implemented upon a mobile device or shopping cart. Attempting to implement the teachings of Treyz via a land based telephone line (as suggested by the Examiner) would defeat the purpose of Treyz. Accordingly, the proposition for which Official Notice was taken is improper. Applicants note, however, that the Official Notice is moot since Treyz did not pre-date the date of invention of the present application, as shown above and as verified by the attachments included herein. Applicants have included the remarks concerning the Official Notice so that the Examiner is aware that Applicants do not agree with the propositions for which Official Notice was taken (thereby preventing the presumption that Applicants implicitly agree with the proposition for which Official Notice was taken).

Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

Date:

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